



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,089	01/18/2006	Andreas Schmidt	P33653US	5419
81722 7590 05/11/2010 Viering, Jentschura & Partner 3770 Highland Ave. Suite 203 Manhattan Beach, CA 90266				
EXAMINER				
HUYNH, NAM TRUNG				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
05/11/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vjp-us@vjp.de
patint@vjp.de

Office Action Summary

Application No.

10/565,089

Applicant(s)

SCHMIDT ET AL.

Examiner

NAM HUYNH

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 2/11/10. Claims 18 and 21-24, and 29-32 were amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 18, 19, 21-29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trossen (US 2004/0111476) in view of Rooke et al. (US 6,678,361).

Regarding claim 18, Trossen teaches a method for transmitting a useful data object (multimedia message (MMS)) from a switching component (MMS relay B) to a mobile station (MMS user agent B), comprising:

selecting (defining a recipient rule) at least one Public Mobile Network (PLMN) in which the useful data object is to be transmitted (paragraphs 30, 32; recipient defines recipient rule that only permits delivery of multimedia messages when connected to one of a limited number of networks such as a 2G, 3G, WLAN, and/or WAN); and

the mobile station storing the selection of the at least one PLMN (network defined in recipient rule) in a storage unit assigned to the mobile station (user database) (paragraph 36);

transmitting the useful data object from the switching component to the mobile station when it is determined that the mobile station is registered in the at least one selected communication network (the communication device is connected to the network defined in the rule for delivery), and it is determined that the switching component has a delivery request for the useful data object (MMS relay B has message to send) (paragraphs 29, 30, 32).

However, Trossen does not explicitly teach that the PLMN is selected by the mobile station with the aid of a selection device assigned to the mobile station. Rooke discloses method for delivering messages (title). Rooke teaches that in response to a notification message that a multimedia message has been sent to a recipient, the terminal and/or user decides how to handle the delivery of the multimedia message based on the result of user input (selection device assigned to mobile station) (figure 2; column 7, lines 19-32). Rooke thus broadly teaches the concept of a user defining how a multimedia message is to be delivered through user input. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the invention of Trossen, to allow the user to define recipient rules through user input on the mobile terminal, as taught by Rooke, in order to avoid storing terminal capabilities and user profile information in the network thereby conserving network resources.

Regarding claim 19, Rooke teaches the mobile station is notified (MMSNotify) by the switching component when the switching component has a useful data object for the mobile station (column 6, lines 7-15).

Regarding claim 21, Trossen teaches the at least one PLMN is selected as a function of at least one parameter, the parameter comprises one of cost of transmitting the useful data object, transmission time for the useful data object, size of the useful data object, the sender of the useful data object, and the nature of the useful data object (paragraphs 32, 33).

Regarding claim 22, Trossen teaches the step of determining whether the mobile station has registered in one of the selected PLMN is performed by a determination device (MMSC and/or rule processor) assigned to the mobile station or the switching component (paragraph 32).

Regarding claim 23, Trossen teaches the determination device notifies the mobile station that the mobile station has registered in one of the selected PLMNs, when it is determined either by the switching component or by the assigned communication device that the mobile station has registered in one of the selected PLMNs (paragraph 39; when connectivity of the recipient changes the recipient knows which network it is connected to).

Regarding claim 24, Trossen teaches the mobile station sends the switching component the delivery request for the useful data object, either when it is determined by the mobile station that the mobile station has registered in one of the selected PLMN, or the mobile station is notified by the determination device assigned to the switching component that the mobile station has registered in one of the selected PLMN (paragraph 32).

Regarding claim 25, Trossen teaches the switching component transmits the useful data object to the mobile station when the delivery request for the useful data object is sent from the mobile station to the switching component or the switching component already has a delivery request (paragraph 29).

Regarding claim 26, Trossen teaches the useful data object is transmitted as a multimedia message in the context of the multimedia messaging service between the switching component and the mobile station (paragraphs 28, 29).

Regarding claim 27, Rooke teaches the mobile station displays to a user, on receipt of a notification that a useful data object is available, the option of selecting from at least two of the following options: transmitting the useful data object from the switching component immediately, at a later time or after registration of the mobile station in the home network or in a previously selected network outside the home network (figure 2, items s23-s25).

Regarding claim 28, Trossen teaches the useful data object is sent from a data provision component (MMS relay A) to the switching component (MMS relay B) for transmission to the mobile station (paragraphs 28, 29).

Regarding claim 29, Trossen teaches at least one of the following information items contained in the useful data object is stored in a storage unit assigned to the mobile station: a status of the transmission process of the useful data object, the at least one selected PLMN, a selected parameter(s), notification and messages, information specific the useful data object (paragraphs 30, 33, 36).

Regarding claim 31, Rooke teaches the storage, the receiving and sending of the useful data object, the selection of the PLMN, the selection of the parameters and/or the display on the mobile station are executed by a software application on the mobile station (column 6, lines 7-17).

Regarding claim 32, the limitations are rejected as applied to claim 18.

4. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trossen (US 2004/0111476) in view of Rooke et al. (US 6,678,361), as applied to claim 29, and further in view of Molne (US 6,014,561).

The combination of Trossen and Rooke teaches the limitations of claim 29, but does not explicitly teach that the information item contained in the useful data object is stored on a SIM card or a UICC card with a USIM application. Molne discloses a method and apparatus for over the air activation of a multiple mode/band radio telephone (abstract). Molne teaches that the SIM card stores information for operation of a handset on two different networks (column 8, lines 14-32). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Trossen and Rooke to allow network information for which the device may communicate with on the SIM, as taught by Molne, in order to

alternatively store network information on the SIM card thus providing the capability to provision the device over the air. Furthermore a skilled artisan would recognize that storage of the information on the network and SIM is interchangeable.

Response to Arguments

5. Applicant's arguments with respect to claims 18, 19, and 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Nam Huynh/
Examiner, Art Unit 2617